

RECEIVED
CENTRAL FAX CENTER

JUN 30 2006

Facsimile Cover

Date: June 30, 2006
To: U.S. Patent and Trademark Office
Fax Number: 571.273.8300
Send Only to the Above Fax Number: x
Confirmation Phone Number:

Calfee, Halter & Griswold LLP

1400 McDonald Investment Center
500 Superior Avenue
Cleveland, Ohio 44114-2688
216.622.8200 Phone
216.241.0816 Fax

1100 Fifth Third Center
21 East State Street
Columbus, Ohio 43215-4243
614.621.1500 Phone
614.621.0010 Fax
www.calfee.com

From: John E. Miller, Esq.
Direct Dial Phone Number: 216.622.8679

Client Number: 28642 Matter Number: 04198 Client Name: Lesco, Inc.

Total Number of Pages: 6

Message:

U.S. Patent and Trademark Office Filing

Re: Serial No. 10/718,052
Title: FERTILIZER

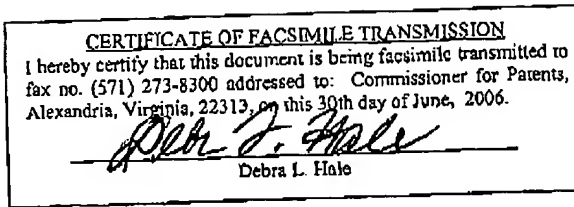
This facsimile transmission contains confidential and/or legally privileged information from the law firm of Calfee, Halter & Griswold LLP intended only for the use of the individual(s) named on the transmission sheet. If you are not the intended recipient you are hereby notified that any disclosure, copying, distribution or the taking of any action in reliance on the contents of this facsimile transmission is strictly prohibited. If you have received this transmission in error, please notify us by telephone immediately so that we can arrange for the return of the documents to us at no cost to you.

If there is a problem with this transmission, please contact the Fax Department at: 216.622.8426, 216.622.8427, or 216.622.8428. Facsimiles can be received 24 hours per day, 7 days a week at 216.241.0816. Thank You.

Fax Operator's Initials:

Sent By: 
Time: _____

Logged By: _____
Time: _____



RECEIVED
CENTRAL FAX CENTER
JUN 30 2006

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of
Paul Michael Ferrell

Serial No.: 10/718,052

Filed: November 20, 2003

For: **FERTILIZER**

Art Unit: 1617

Examiner: S. Clardy

Customer No.: 24024

Attorney Docket No.: 28642/04198

Confirmation No.: 9298

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION

Dear Sir:

Dear Sir:

Please reconsider and withdraw the rejections in the Office Action of May 10, 2006, for the following reasons:

The examiner has failed to make out a prima facie case of obviousness with respect to the subject matter claimed, because (1) the only nexus between the cited references is applicant's own disclosure and (2) following the disclosures of the cited references would lead one of ordinary skill in the art to an entirely different process and product form that claimed.

As previously indicated, prodiamine-impregnated fertilizers are already known. They are formed by mixing powdered prodiamine with dry particulate fertilizer so that the prodiamine powder particles stick to the surfaces of the particulate fertilizer. Mineral oil can be added to improve adhesion. The problem with this approach, however, is that prodiamine powder is flammable when handled. Accordingly, applicant's objective in making the present invention was to develop a new way of making prodiamine-impregnated fertilizers which not only avoided this flammability problem but also was physiologically and environmentally safe. Applicant achieved

Appl. No. 10/718,052
Amdt. of June 30, 2006
Reply to O.A. of May 10, 2006

this objective by dissolving the prodiamine in an organic solvent meeting three specific criteria (solvency, toxicity and combustibility) and impregnating the particulate fertilizer with this solution.

According to the examiner, this solution is *prima facie* obvious primarily in view of Ross et al. which teaches that herbicide-impregnated fertilizers can be made by spraying. See, the first column on page 110 of Ross et al. However, the primary focus of this reference is in using water as the carrier. That being the case this reference, if anything, would lead one of ordinary skill in the art seeking to solve applicant's problem to impregnate fertilizer substrates with **aqueous dispersions** of prodiamine rather than **organic solutions** of this herbicide, as accomplished in the inventive process.

In addition to water, Ross et al. does indicate that diesel oil as well as mineral oil can be used as carriers. See, the second column on page 109. However, this disclosure is obviously made in connection with applying herbicide/oil mixtures directly to plants. ("Oils usually serve as carriers for special uses. Diesel and other mineral oils are used routinely for dormant applications of herbicides to woody species.") It is not made in connection with impregnating fertilizers. Thus, there is no fair suggestion in this reference of using **organic liquids** as carriers for impregnating fertilizers, as accomplished in the present invention. And there clearly is no suggestion of using organic liquids which are capable of **dissolving** the herbicide being applied, which is also an important feature of this invention.

To remedy the defects of Ross et al., the examiner relies on Weston and Zagar et al. Weston is pertinent because it shows incorporating a herbicide into urea fertilizer particles by first dissolving the herbicide into NMP (N-methyl pyrrolidone), as done in some embodiments of the inventive process. However, a critical feature of Weston's process is that this herbicide/NMP solution is mixed with **molten urea** before it is granulated or prilled into particles. See, col. 7, lines 32-42. This is necessary so that the herbicide is homogenously distributed in the fertilizer particles, which is an important feature of the Weston's process. See, col. 7, line 40, col. 10, line 45 and col. 11, line 16. That being the case, one of ordinary skill in the art would reject using NMP as a carrier in Ross et al.'s impregnating process, since there is no fair disclosure in Ross et al. that anything but water will work for this purpose.

In this connection, it is important to remember that granular fertilizers such as urea function by **dissolving** in rain water. That being the case, (1) the express disclosure in Ross et al. that diesel

Appl. No. 10/718,052
Amdt. of June 30, 2006
Reply to O.A. of May 10, 2006

and mineral oils are used only for "special uses," (2) Ross et al.'s failure to expressly disclose using diesel or mineral oils for impregnating fertilizers, and (3) Ross et al.'s clear preference for water as the carrier would immediately suggest that organic liquids in general could not be used in Ross et al.'s fertilizer-impregnating process, since they would not provide the same solvating effect as water. That being the case, the clear teaching in Watson that NMP can be used as a carrier only if the urea to which it is added is molten in form would only reinforce Ross et al.'s clear suggestion that water, not organic solvents, must be used as the carrier in its impregnating process. Thus, the combination of Watson and Ross et al. would clearly direct a person of ordinary skill in the art to reject Watson's NMP in Ross et al.'s impregnating process and use water instead.

The clear deficiencies of Ross et al. and Watson are not remedied by Zagar et al. It is true that Zagar et al. discloses that prodiamine is a herbicide. *See*, Paragraph [0115]. In addition, Zagar et al. also discloses that NMP can provide a carrier function for herbicides. *See*, Paragraph [0280]. Similarly Zagar et al. also discloses that solid granules of urea can also provide a carrier function for herbicides. *See*, Paragraph [0284]. However, each of these disclosures is made as a part of a much larger disclosure and none of these disclosures is directly related to one another.

For example, the disclosure in Paragraph [0115] that prodiamine is a herbicide is part of a much larger disclosure spanning some 38 ½ columns of the Zagar et al document specifically disclosing hundreds of thousands of herbicide compounds by name and formula and generically disclosing millions more. Similarly, the disclosure in Paragraph [0280] that NMP can provide a carrier function is part of a much larger disclosure in this paragraph that a wide variety of different organic liquids, as well as water (Paragraph [0276]), can provide this function. In the same way, the disclosure in Paragraph [0284] that solid granules of urea can also provide a carrier function is part of a much larger disclosure that a wide variety of different solid materials can provide this function. Nothing in these lists indicates a preference for prodiamine, for NMP or for impregnated urea, and hence there is nothing in this record tying these isolated disclosures together other than applicant's own disclosure.

In this connection, the Federal Circuit has made clear that a broad generic disclosure is insufficient to support a *prima facie* case of obvious with respect to a specific combination wholly encompassed within that generic disclosure where there is nothing in the reference to point to the combination. *See, e.g., In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994)

Appl. No. 10/718,052
Amdt. of June 30, 2006
Reply to O.A. of May 10, 2006

("No particular one of the DNAs can be obvious unless there is something in the prior art to lead to the particular DNA and indicate that is should be prepared.") 16 F.3 at 382. *See, also, In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). Moreover the PTO has expressly embraced this proposition of law in MPEP §2144.08 II (Page 2100-155).

In this case, the possible combinations of herbicides, liquid carriers and solid carriers made possible by combining the individual disclosures of Paragraphs [0115], [0276], [0280] and [0284] of Zagar et al. are infinite. Moreover fairly considered, the disclosures in Paragraphs [0280] and [0284] relating to liquid and solid carriers, respectively, are alternatives to one another, not options to be combined. Under these circumstance, it is clear that Zagar et al. does not fairly suggest impregnating a urea solid carrier with a prodiamine herbicide dissolved in an NMP liquid carrier, as the examiner apparently asserts. That being the case, Zagar et al. does not alter the clear suggestion in Ross et al. and Watson that water, not organic solvents, must be used as the carrier in Ross et al.'s impregnating process.

The Federal Circuit has repeatedly emphasized that it is impermissible within the framework of 35 USC §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to a full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Baush & Lomb, Inc. v. Barnes-Hind, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986).

In this case, the Examiner ignores the express teaching in Ross et al. that water is the carrier of choice and that diesel oil and mineral oil are appropriate only for "special uses." In addition, he ignores the fact that water solvates particulate fertilizers while organic solvents generally do not. Similarly, he ignores the express teaching in Watson that NMP can be used as a carrier for combining a herbicide with urea only if the NMP is added while the urea is molten in form. Finally, he also ignores the fact that Zagar et al.'s shotgun disclosure implicitly covers an infinite number of combinations with nothing pointing to the specific combination of prodiamine, NMP and urea.

Under these circumstances, it is clear that the motivation to combine the references as done in this rejection is based on a hindsight reading of the prior art using applicant's own specification as a guide and not an impartial assessment of what this prior art fairly suggests.

Appl. No. 10/718,052
Amdt. of June 30, 2006
Reply to O.A. of May 10, 2006

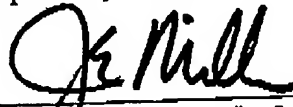
Finally, MPEP §2142 makes crystal clear that, to establish a *prima facie* case of obvious, the prior art must provide a disclosure or suggestion of all features being claimed. Here, none of the cited references expressly shows impregnating fertilizer particles with a solution of a herbicide in an organic solvent. Moreover, because organic solvents do not have the same solvating characteristics as water, none of these references suggest this approach either.

Accordingly, not only is this rejection fatally defective for hindsight, it is fatally defective for failing to suggest all features of the claimed invention as well.

Thus, this rejection is untenable and should be withdrawn.

If any additional fees are due, please charge our Deposit Account No. 03-0172.

Respectfully submitted,



John E. Miller (Reg. No. 26,206)
(216) 622-8679

Date

6/30/06